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OFFICE OF PETITIONS

In re Application of
Rohan Coelho
Application No. 10/039,210
Filed: January 4, 2002
Title: REAL-TIME PRESCRIPTION
TRANSACTION WITH ADJUDICATION
ACROSS A NETWORK

DECISION REFUSING STATUS
UNDER 37 CFR §1.47(b)

This is in response to the petition under 37 CFR §1.47(b), filed June 18, 2002 (certificate of mailing June 5, 2002).

The petition under 37 CFR §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on January 4, 2002, with an unexecuted declaration naming Rohan Coelho as sole inventor. Accordingly, on February 5, 2002, applicant was mailed a "Notice to File Missing Parts of Application," requiring an executed oath or declaration, and a surcharge for late filing. This Notice set a period for reply of two months, with extensions of time obtainable under §1.136(a).

With the instant petition, petitioner submitted a declaration executed by Steven P. Skabrat, as agent for assignee Intel Corporation, on behalf of non-signing sole inventor Rohan Coelho; and paid the surcharge for late filing. To make the reply time, the petition was accompanied by a petition for extension for response within the second month (and fee). Applicant maintains that status under 37 CFR §1.47(b) is proper because sole inventor Coelho has, by his conduct, refused to join in the application. In support thereof, rule 47(b) applicant submits the declarations of prosecuting patent attorney James H. Salter and agent for assignee Steven P. Skabrat..

§1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned

or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

Accordingly, a grantable petition under 37 CFR §1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 C.F.R. §1.63 and 1.64 or 1.175; (2) the rule 47 applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) rule 47 applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP §409.03(g).

See 35 U.S.C. §118; 37 C.F.R. §1.47; §§409.03 and 605 of the *Manual of Patent Examining Procedure* (8th ed) (Rev. 1, Aug. 2001) (MPEP).

The petition and declaration have been reviewed and found to satisfy requirements (2)-(7) above.

However, the petition does not satisfy requirement (1) above:

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP §324.

Rule 47(b) applicant has not provided an acceptable declaration because applicant has not shown that attorney Skabrat

has the authority to execute the declaration for patent on behalf of assignee Intel Corporation. The Office does not presume that the title "Agent" empowers attorney Skabrat with the authority to sign on behalf of assignee Intel in reference to this application. The petition does not include proof of attorney Skabrat's authority in the form of a statement signed by an appropriate corporate officer. Nor does attorney Skabrat state that he is authorized to sign on behalf of the corporation. Rather, attorney Skabrat states "[a]s an employee of Intel Corporation, I believe I have sufficient legal basis to act on behalf of and as agent for sole uncooperative inventor, Rohan Coelho." This is insufficient. It is not a definite statement of authority and it speaks to acting on behalf of the inventor and not in terms of being authorized to sign on behalf of the assignee. See also 37 CFR 3.73(b)(2).

Accordingly, the petition must be dismissed. On Request for Reconsideration, to avoid abandonment and attain 1.47 status, applicant must correct the noted deficiency and provide a 1.47 petition in compliance with all applicable law. As the 3.73(b) statement should be submitted prior to or with the paper in which action is taken, rule 47(b) applicant should submit a newly executed declaration including the appropriate statement of authority.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
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By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
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Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.


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for Patent Examination Policy